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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,321	01/29/2004	John W. Taylor	9968-53U1	5500
570 7590 11/21/2007 AKIN GUMP STRAUSS HAUER & FELD L.L.P. ONE COMMERCE SQUARE 2005 MARKET STREET, SUITE 2200 PHILADELPHIA, PA 19103			EXAMINER UTAMA, ROBERT J	
			ART UNIT 3714	PAPER NUMBER
			MAIL DATE 11/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/767,321

Applicant(s)

TAYLOR ET AL.

Examiner

Robert J. Utama

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01/29/2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group 1 claim 1-10 in the reply filed on 09/13/2007 is acknowledged. The examiner notes the applicant elected group 1 with traverse, however, the examiner noted that the applicant's reply filed on 09/13/2007 do not contain any argument to traverse the restriction made by the examiner. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claim 1 rejected under 35 U.S.C. 103(a) as being unpatentable over Jeng US 4,809,246**

**Claim 1:** Jeng provides a teaching of a book encoded for optical page identification (see Jeng FIG. 2 item H1-H3). Jeng provides a teaching a first sequence of page identifiers associated with a first sequence of the plurality of successive of the first sequence of successive page identifiers (see Jeng FIG. 2 item 6a and 7a) and the first sequence of successive page identifiers comprising overlayable arrangement of open-hole and closed-hole location (see Jeng col. 3:40-52), each successive arrangement of the sequence increasing in total number of open hole location by at least one open hole location (see Jeng Col. 5:12-22).

Jeng provides a teaching a second sequence of page identifiers associated with a first sequence of the plurality of successive of the first sequence of successive page identifiers) and

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the first sequence of successive page identifiers comprising overlay able arrangement of open-hole and closed-hole location, each successive arrangement of the sequence decreasing in total number of open hole location by at least one open hole location. However, the examiner notes that the Jeng's overall teaching is that one page can be differentiated from another by page by having at least one hole different between one page and next page as seen in the example of FIG 5 and col. 5:15-20. It would have been obvious to have a set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location by duplicating the code found in Jeng Col. 5:12-22 and arranging such that there is always one open hole difference between consecutive page. The examiner also provides how such duplication can be accomplished (see Table 1 below). The examiner also notes that one can extend the number of pages that can be detected simply by duplicating the page marking and the photo sensor (FIG 5. item P1-P4).

0000	duplicated	4 open
0001	duplicated	3 open
0011	duplicated	2 open
0111	duplicated	1 open
1111	Jeng's disclosure	0 open
0111	Jeng's disclosure	1 open
0011	Jeng's disclosure	2 open
0001	Jeng's disclosure	3 open
0000	Jeng's disclosure	4 open

**Table 1**

Therefore, the examiner concludes that the Jeng references discloses the claim invention except for the limitation of a second sequence of page identifiers associated with a first sequence of the plurality of successive of the first sequence of successive page identifiers) and

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the first sequence of successive page identifiers comprising overlay able arrangement of open-hole and closed-hole location, each successive arrangement of the sequence decreasing in total number of open hole location by at least one open hole location. It would have been obvious to one having ordinary skilled in the art to create a second sequence of successive page identifiers by duplicating the code disclose in the Jeng references (see earlier explanation and Table 1), since it has ben held that mere duplication of essential working parts of device involves only routine skill in the art. *St Regis Paper Co. v. Bemis Co.* 193 USPQ 8.

**4. Claim 2-9 rejected under 35 U.S.C. 103(a) as being unpatentable over Jeng US 4,809,246 and in view of Kim et al US 6,865,367**

**Claim 2 and 9:** Jeng provide a teaching where each arrangement of the first sequence of successive page identifier, have at least one closed hole location on the first correspond page of the first corresponding page spread (see Col. 5:12-22). Jeng does not provide teaching where at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location. However, Kim provides a teaching at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location (see Kim col. 4:35-43). Therefore it would have been obvious to one of ordinary skilled in the art to include the feature of at least one closed hole location having a first optical reflectance detectably different than a second optical of the first area adjacent to at least one closed-hole location, as taught by Kim, in order to increase the accuracy of the photo-sensors (see Kim col. 4:48-55).

Jeng does not provide a teaching of another set of page identifiers that correspond the other page spread. It would have been obvious to have a set of page identifiers that correspond the other page spread, having an overlay-able arrangement of adjoining open and close hole location, each successive arrangement of the decreasing in total number of open hole location by at least one open hole location by duplicating the code found in Jeng Col. 5:12-22 and

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arranging such that there is always one open hole difference between consecutive page (see Claim 1 rejection). Kim provides a teaching at least one closed hole location having a third optical reflectance detectably different than a fourth optical of the first area adjacent to at least one closed-hole location (see Kim col. 4:35-43). Therefore, it would have been obvious for one ordinary skilled in the art to include the feature of another set of page identifiers that correspond the other page spread, as taught by Kim, into the book-apparatus of Jeng in order to increase the accuracy of the photo-sensors (see Kim col. 4:48-55).

**Claim 3, 5, 7 and 8:** Jeng provides a teaching of having open hole location located on a page of the plurality of pages and is defined by an elongated closed perimeter opening through the page (see FIG 2 item H1-H3). Also Jeng's open hole location is located through the one page proximal a free page of a page (see FIG 2 item H1-H3).

**Claim 4 and 6:** Jeng does not provide a teaching of open hole that is defined by cutout extending inwardly from a proximal edge of the page. Instead Jeng provides a teaching of an elongated closed perimeter opening through the page

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to create a cutout extending inwardly from a proximal edge of the page. Because the applicant has not provide a particular advantage having create a cutout extending inwardly from a proximal edge of the page, or solved a particular problem. One of ordinary skilled in the art would have expected that the elongated closed perimeter opening through the page and the proposed cutout extending inwardly from a proximal edge of the page to work, would be able to perform the same function of letting light reach the photo sensors. Therefore, it would have been prima facie obvious to modify Jeng to obtain the invention as specified in claim 4 and 6 because such a modification would have been considered a mere design consideration which fails to patentably distinguish over the prior art of Jeng.

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***Response to Arguments***

5. Applicant's arguments with respect to claim 1-9 have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's response and amendment on claim 1, 2 and 9 is effective to overcome the rejection under 35 U.S.C 112, second paragraph.

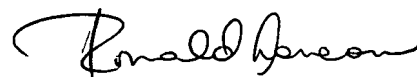
***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert J. Utama whose telephone number is (571) 272-1676. The examiner can normally be reached on M-F 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezutto can be reached on (571)272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

RU



RONALD LANEAU  
PRIMARY EXAMINER

11/17/07